

Applicant(s): Grasso et al.
Appl'n No. 09/377,081

D. Remarks

This amendment is made for the sole purpose of expediting prosecution in view of the Examiner's recognition of allowable subject matter. No new matter is added. Claims 1-3, 5, 7, 12, 15, 17, 18, 31-33, 43-44, 46-47, 49-55 and 57-60 are in the case after the entry of this amendment. The Examiner withdrew claims 5, 43-44, 46-47, 49-55, and 57-60 as drawn to a non-elected invention. As such, claims 1-3, 7, 13-15, 17-18, 31-33 and 61 are under examination, with the species corresponding to SEQ ID NO: 18 elected.

Applicant has amended the claims so as to clarify and more particularly indicate the claimed subject matter, and to better indicate that the claimed subject matter is to the novel and unobvious peptides of the invention.

Written Description

Rejection of Claims 1-3, 7, 8-18, 31-34 and 39 under 35 U.S.C. §112, first paragraph

The Examiner rejected claims 1-3, 7, 8-18, 31-34 and 39 under 35 U.S.C. §112, first paragraph. Solely to advance this case to allowance, Applicants have deleted reference to "homologs, analogs or derivatives" in the claims. As such, Applicants respectfully submit that the rejection is overcome, and request withdrawal thereof.

Enablement

Rejection of Claims 1-4, 6-18, 31-34, 39, 45, 48, 56 and 61 under 35 U.S.C. §112, first paragraph

The Examiner rejected claims 1-4, 6-18, 31-34, 39, 45, 48, 56 and 61 under 35 U.S.C. §112, first paragraph, as containing subject matter not adequately described in the specification so as to enable one of ordinary skill in the art to make and/or use the invention. Applicants appreciate the recognition that the specification is enabling for leptin fragments containing SEQ ID NOs: 2 or 18; solely to advance the case to allowance, Applicants have amended the claims to recite, *e.g.*, in claim 1, purified leptin peptide ≤ 15 amino acids long, having a sequence selected from the group consisting of SEQ ID NOS: 2-10 and 18. Claim 7 has been rewritten in independent form to claim OB-3 peptides selected from the group consisting of: amino acid residues ¹¹⁶Ser-Cys-Ser-Leu-Pro-Gln-Thr¹²² of mouse leptin protein (SEQ ID NO:2) and ¹¹⁶Ser-Cys-His-Leu-Pro-Trp-Ala¹²² of human leptin protein (SEQ ID NO:18.) Claim 12 now recites a peptide consisting essentially of an amino acid sequence from the list presented in the claim. Applicants' specification provides proper and sufficient enabling support for these peptides.

In view of the claim amendments and Applicants' comments, it is respectfully submitted that they properly and sufficiently address the Examiner's concerns. As such, the rejection has been overcome, and Applicants request withdrawal of the rejection.

Indefiniteness

Rejection of Claims 8-11 and 45 under 35 U.S.C. §112, second paragraph

The Examiner rejected 8-11 and 45 under 35 U.S.C. §112, second paragraph, as indefinite in view of the presence of "mammalian", "murine", "human" and "synthetic". To advance the case to allowance, these claims have been canceled without prejudice or disclaimer, mooting the rejection. Withdrawal of the rejection is appropriate and requested.

Novelty

Rejection of claims 4, 6 and 12 under 35 U.S.C. §102(a/b) over Grasso et al.

Claims 4, 6 and 12 were rejected as anticipated by Grasso *et al.* (*Endocrinol.* 138: 1413-1418, 1997) ("Grasso"). Applicants traverse.

Claims 4 and 6 are cancelled herein without prejudice or disclaimer, so the rejection is moot as applied to those claims. In regard to amended claim 12, Grasso does not teach or suggest the presently claimed invention, *i.e.*, a peptide consisting essentially of an amino acid sequence selected from SEQ ID NOS: 2-10 and 18. The leptin fragments described in Grasso are identified in the specification as SEQ ID NOS: 11-16. It is settled law that a reference that does not describe each and every element of a claimed invention cannot be a bar to patentability under 35 U.S.C. §102. *see, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986). Grasso does not teach or suggest the presently claimed invention, and as such, Grasso is not prior art to the present invention. Applicants request that the rejection be withdrawn.

Rejection of claims 4, 6, 12 and 61 under 35 U.S.C. §102(a) over Al-Barazanji et al.

Claims 1-4, 6-18, 39 and 61 were rejected as anticipated by Al-Barazanji *et al.* (PCT Publication WO 97/46585, published 12/11/97) ("Al-Barazanji"). Applicants believe this rejection is moot as applied to the claims as now pending.

Claims 4, 6, 13-14, and 39 are cancelled herein without prejudice or disclaimer, so the rejection is moot as applied to those claims. In regard to claim 12, Al-Barazanji does not teach or suggest the presently claimed invention, *i.e.*, a peptide consisting essentially of an amino acid sequence selected from SEQ ID NOS: 2-10 and 18. Al-Barazanji fails to describe any of the claimed purified leptin peptides, including not disclosing the polypeptide of SEQ ID NO:18. Lastly, with respect to amended claim 61, which claims a purified peptide consisting essentially of the amino acid residue sequence of SEQ ID NO:18, Al-Barazanji does not anticipate the claimed invention. Applicants respectfully submit that the claim transition language in the amended claims is sufficient to distinguish the presently claimed invention from that of Al-Barazanji and the other cited references.

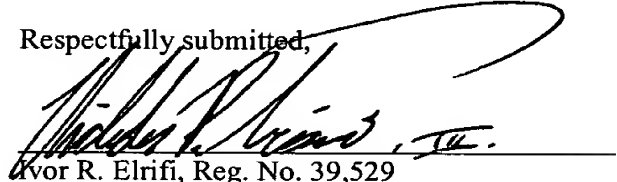
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Applicants respectfully therefore submit that in view of the above statements and amendments, withdrawal of this rejection is in order and is respectfully requested.

SUMMARY

On the basis of the foregoing amendments, Applicants respectfully submit that the pending claims are in condition for allowance. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact either of the undersigned at the telephone number provided below.

Respectfully submitted,



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